

PATENT
790001-2045**REMARKS**

Reconsideration and withdrawal of the rejections of this application and consideration and entry of this paper are respectfully requested in view of the herein remarks, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

With the cancellation of claims 3 and 8, claims 1, 2, 4-7 and 9-19 are now pending. Claims 1, 2, 4-7 and 9-13 are under examination and claims 14-19 have been withdrawn from consideration.

Claims 1 and 7 have been amended by included the claim language of cancelled claims 3 and 8 respectively. Claim 1 has also been amended to comprise a second semiconductor layer which is in contact with a region included in a first semiconductor layer and is surrounded by an insulating film. Support for this claim language can be found in the specification, e.g. the region A1 shown in Figures 3A and 3B.

Claim 14 has been amended to link the semiconductor device to the device of claim 1 in order to allow the method of making claims 14-19 to be rejoined with the device claims (see MPEP 821.04).

No new matter has been added by these amendments. The applicants reserve the right to pursue claims 1 and 7 as originally filed in a continuing or divisional application.

The applicants acknowledge and appreciate the Examiner's recognition of allowable subject matter regarding claims 8 and 9.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. THE 35 U.S.C. §§102(b) and 102(e) REJECTIONS HAVE BEEN OVERCOME

Claims 1, 2, 7, 10 and 11 were rejected as allegedly being anticipated by Inaba et al. (U.S. Patent 6,525,403 – "Inanba").

Claims 1, 3 and 4 were rejected as allegedly being anticipated by Mathew et al. (U.S. Patent Application Publication 2003/0151077 – "Mathew").

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Claims 1-4, 7, 10 and 11 were rejected as allegedly being anticipated by Lee (U.S. Patent 6,885,055 – “Lee”).

Reconsideration of each of these rejections in light of the amendments made to the claims is requested.

In order to establish that a claim has been anticipated, the reference must teach every element of the claim. MPEP 2131, see also *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (“The identical invention must be shown in as complete detail as is contained in the ... claim.”).

While the applicants do not necessarily agree with the Examiner’s characterization of the Inaba, Mathew and Lee references, it is clear that:

(1) Inaba fails to disclose a structural feature corresponding to “the third and fourth semiconductor layers being isolated from the first semiconductor layer by the insulating film”.

This point was recognized by the Examiner as claim 3 was not included in the anticipation rejection over Inaba.

(2) Mathew and Lee do not teach a structural feature corresponding to “the second semiconductor layer being in contact with a region included in the first semiconductor layer and surrounded by the insulating film”. (Mathew only refers to a structural feature wherein a silicon layer 18 and a semiconductor substrate 12 being electrically isolated by an insulator 14. Lee refers to a source and drain region which are formed on both sides of the Fin active region 4, except where the gate 16 overlaps with the Fin active region 4 - see also col. 5, lines 48-51. However, this overlap is manifested by having both sides of the Fin active region 4 being in contact with a silicon substrate 2b).

Therefore, for the reasons cited above, the Inaba, Mathew and Lee references all fail to teach every element of the applicants’ claimed invention as amended and these rejections can be withdrawn.

IV. THE 35 U.S.C. 103(a) REJECTION HAS BEEN OVERCOME

Claims 5, 6, 12 and 13 were rejected as being allegedly being obvious over Nagasaka et al. (U.S. Patent 6,300,683 – “Nagasaka”) in view of Lee, *ibid*.

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The applicants are a bit confused by the structure of this rejection as claims 5 and 6 are dependent upon claim 1 and claims 12 and 13 are dependent upon claim 7. Moreover, Nagasaka was not cited in the Examiner's anticipation rejections. Should the rejection have been Lee in view of Nagasaka?

In any event, in order to establish a *prima facie* case of obviousness, all the claim limitations must be taught or suggested by the prior art. see MPEP 2143.03. Lee was addressed above and established that all elements of the applicants' claimed invention as amended are not taught. The Nagasaka reference appears to be relied upon to supply the elements of claims 5, 6, 12 and 13 which are missing from Lee and not to the structural feature "the second semiconductor layer being in contact with a region included in the first semiconductor layer and surrounded by the insulating film". Therefore, even if Lee and Nagasaka could be properly combined, all limitations would not be taught or suggested by the prior art and no *prima facie* case of obviousness exists.

REQUEST FOR INTERVIEW

In the interest of adhering to the tenets of compact prosecution and obtaining good customer service (see page 7 of the FY-2004 Performance and Accountability Report), the applicants request that the teachings of MPEP 707.07(j), sections II and III be applied, especially with regard to the offer of suggestion for correction by the Examiner if the rejections are upheld.

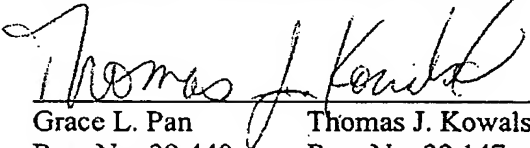
In accordance with MPEP 713.01, section III, should any issue remain as an impediment to allowance, an interview with the Examiner and SPE are respectfully requested; and, the Examiner is additionally requested to contact the undersigned to arrange a mutually convenient time and manner for such an interview ("An interview should normally be arranged for in advance, as by letter, facsimile, electronic mail, telegram or telephone call, in order to insure that the primary examiner and/or the examiner in charge of the application will be present in the office." *Id.*).

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In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,
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